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Hiroyuki Sekitani

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RECORD OF ORAL HEARING  
  
UNITED STATES PATENT AND TRADEMARK OFFICE  
  
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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte HIROYUKI SEKITANI

\_\_\_\_\_  
  
Appeal 2006-3294  
Application 09/880,036  
Technology Center 3600  
  
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Oral Hearing Held: November 15, 2007  
  
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Before HUBERT LORIN, ANTON W. FETTING, DAVID B. WALKER,  
Administrative Patent Judges

ON BEHALF OF THE APPELLANT:

RYAN B. CHIRNOMAS, ATTORNEY  
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The above-entitled matter came on for hearing on November 15, 2007, at the  
U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia,  
before Dominico Quattrociocchi, Free State Reporting, Inc.

1 PROCEEDINGS  
2

3 JUDGE WALKER: Hello, this is Judge Walker in Hearing Room B.  
4We are ready for Calendar Number 38. Thank you.

5 MS. BEAN: Good morning, Calendar Number 38, Mr. Chirnomas.

6 JUDGE LORIN: Mr. Chirnomas?

7 MR. CHIRNOMAS: Yes.

8 JUDGE LORIN: Did I say your name correctly?

9 MR. CHIRNOMAS: Chirnomas, yep.

10 JUDGE LORIN: Good morning, Counsel.

11 MR. CHIRNOMAS: Good morning.

12 JUDGE LORIN: This is Appeal Number 2006-3294. Correct?

13 MR. CHIRNOMAS: 2006-3294, yes.

14 JUDGE LORIN: Very good. Okay, Counsel, we're familiar with the  
15case. You have 20 minutes.

16 MR. CHIRNOMAS: Okay.

17 JUDGE LORIN: You may proceed.

18 MR. CHIRNOMAS: Well, would you like a brief summary of the  
19invention or you're already --

20 JUDGE LORIN: You can get to the issues --

21 MR. CHIRNOMAS: Okay.

22 JUDGE LORIN: -- the issues in the case.

23 MR. CHIRNOMAS: Okay. Well, the issue is, essentially, the key  
24issue is in Claim 1 on Lines 4 and 5, it says a terminal connected to the part  
25data base via a communication network or by directional communications  
26with the part data base. And that's what has been an issue with the

1Examiner. Throughout prosecution the Examiner was arguing that the part  
2data base in Calloway was located in the central computer 26, which you can  
3see in Figure 1-B. In the Appeal Brief we again argue that it is not. In the  
4Examiner's answer, it appears that the Examiner has sort of shifted his  
5argument a bit and it appears that the Examiner now believes that -- he  
6doesn't seem to be holding to the idea that the data base is stored in the  
7central computer rather, it appears that he is saying it's in the work station  
8which you see also in Figure 1-B, but that it's connected over a network.  
9And we would argue, as we have from the beginning, that the connection  
10that you see in Figure 1-B between the local data base and the work station  
11is simply a bus. Whether is be an internal bus within a box or an external  
12bus, you know, inside a box. It's not a network. And, and that's really what  
13it comes down to. It appears that the Examiner is also in the Examiner's  
14answer making a obviousness rejection, but the rejection at issue is 102 and  
15so -- I mean we simply believe it's not there. If the Examiner wishes to  
16reopen prosecution and make a 103 rejection, you know, that's fine, but  
17Calloway simply does not anticipate the claims as written.

18 JUDGE FETTING: I mean, the Examiner essentially tries using the  
19dictionary definition of, of a network to say under the broadest  
20interpretation, a bus is essentially, is essentially a communication network.  
21It's, it, it provides essentially the same type of a function and we're just  
22arguing over, you know, whether there's multiple computers tied to this  
23thing or whether it's, you know, or whether it's just dedicated to it. I mean,  
24so it, it just comes down to a construction is -- does it in fact just come down  
25to construction as to whether a bus is in fact a species of a communication  
26network?

1 MR. CHIRNOMAS: Well, I guess how I respond to that is first of all  
2that, that definition has not been formally made of record. I haven't seen it  
3other than in the text of the Examiner's answer. Secondly, you know, I  
4would say there is a distinction to one who's skilled in the art between a bus  
5and a network. If you have your PC at home connected to a mouse, is that a  
6network between your mouse and a, and the processor itself or between the  
7monitor? I believe these things aren't. It's not two computers connected  
8and, you know, that being the case, you know, it seems like this is more a  
9place for a 103 rejection. You might be wondering, well why didn't you  
10amend the claims to say that the part data base is located in the server. That,  
11that could alleviate any confusion over, you know, what this line here is;  
12whether it's a bus or, or a network. Well the reason why is because  
13throughout prosecution the Examiner was saying, it's in the server or central  
14computer or whatever you want to call it, and, you know. So we did not  
15make such an amendment because it would have been, you know, wouldn't  
16have gotten us anywhere with the Examiner, but I would say that to one  
17skilled in the art there is a difference between a network and a bus. You  
18know, we haven't argued these issues and brought all of these definitions  
19out, but there, there are two different terms that have different meanings to  
20one skilled in the art. You know, it's not even clear whether this is all  
21within one, one physical computer or, you know, this dotted line -- it's not  
22really very well explained in Calloway, but, you know, is this all within one  
23box? Is the modem internal? We just talking about wires within a  
24computer. Well, I don't think one having ordinary skill in the art would say  
25that wires within a computer are a network.

26 JUDGE FETTING: Well, the, the video disk is, is referenced as

1saying that it has a computer embedded within it. So at least the computer in  
2the video disk is communicating with the work station computer. So  
3arguably the communication between the two of them would be a network  
4type of communication.

5 MR. CHIRNOMAS: Meaning, meaning there was a computer within  
6--

7 JUDGE FETTING: Within the video disk, yes.

8 MR. CHIRNOMAS: Well, that, that may be, that may be the case,  
9however if that were the case then that computer or terminal, whatever you'd  
10like to call it, that would be bodily incorporated within the video disk would  
11also have to have the limitations in the rest of the claim; the part requesting  
12means, the storage means, all of these. So we say, you know, a terminal  
13connected to the part data base be a network. So if you, if you were to say,  
14well this is a network right here --

15 JUDGE FETTING: Right.

16 MR. CHIRNOMAS: -- then this would have to be your, your  
17terminal.

18 JUDGE FETTING: Why would that have to be your terminal? Why  
19wouldn't the computer be the terminal? Why wouldn't the work station  
20computer be the terminal?

21 MR. CHIRNOMAS: Because if you're saying that the terminal is  
22connected via network to the data base -- if we're arguing that this is, this is  
23the network and this is the data base --

24 JUDGE FETTING: Well, the video disk is the data base also.

25 MR. CHIRNOMAS: The video disk is a data base also?

26 JUDGE FETTING: It's a data base of video images that describe the

1parts.

2 MR. CHIRNOMAS: Um-hum, um-hum.

3 JUDGE FETTING: By the way, I'm referring to Column 2; Lines 60  
4to 62 that describe the computer based interactive video disk system. So  
5that's, that's -- so it is disclosed. The video disk is disclosed as having a  
6separate computer system within it. But, but I mean the overriding question  
7that I have and I know this is a 102 --

8 MR. CHIRNOMAS: Yeah.

9 JUDGE FETTING: -- is that people have been using -- haven't  
10people been using data base servers for at least 20 years. Why isn't this at  
11least a 103 if to use a data base server for your data base?

12 MR. CHIRNOMAS: Well, that seems like a question that's better  
13directed to the Examiner why it's not, why it's not making -- why the  
14Examiner isn't making a 103 rejection. Is that your question?

15 JUDGE FETTING: Well, why -- okay if you had a 103 in front of  
16you, how -- why would, you know -- why would you get a patent? Why,  
17why do you think you would, you would be able to overcome a 103  
18rejection?

19 MR. CHIRNOMAS: Well, I mean I guess I'd rather not theorize on a  
20103 rejection without having seen the merits --

21 JUDGE FETTING: Okay. Is there any quarrel about the notoriety of  
22data base servers?

23 MR. CHIRNOMAS: In and of themselves?

24 JUDGE FETTING: In and of themselves.

25 MR. CHIRNOMAS: No.

26 JUDGE FETTING: In the manufacturing environment, is there any

1quarrel with the use of data base servers in a manufacturing environment?

2 MR. CHIRNOMAS: Well, its', it's sort of where, where the data base  
3is, is located. In, in the art that is cited here, it's all local and the idea is that  
4you have a data base that replaces a big fat book that you use for, for, you  
5know, ease of navigation through, let's say a machine that has --

6 JUDGE FETTING: Right.

7 MR. CHIRNOMAS: -- 10,000 parts.

8 JUDGE FETTING: The only issue as I understand it, and correct me  
9if I'm wrong, is whether it would have been obvious to have used a data  
10base server rather than a local data base within a computer.

11 MR. CHIRNOMAS: Right. Well, I'd say, I'd say it wouldn't be  
12because part of the inventive aspect of our, of our application here is that  
13you have a complicated machine that has thousands of parts and these parts  
14are going to be -- their configurations are going to change over time. The  
15manufacturing is going to decide whether to make this gear out of titanium  
16instead of steel, or what not. And the user wouldn't necessarily want to keep  
17buying an updated parts list and all this. And you don't want to place an  
18order for a part number that doesn't exist any more. So the idea is that you  
19have this server with, you know, machine manufacturing incorporated in  
20their -- at their corporate site and you say, well I need, I need a part for my  
21machine. You ask for the updated information. They give you the latest and  
22greatest; what the part numbers are and all that, and then you can order  
23quickly and efficiently.

24 JUDGE FETTING: And isn't that in fact what data base servers are  
25there for; to provide one central repository rather than having to replicate the  
26data base all over the place?



1 MR. CHIRNOMAS: I suppose, yes.

2 JUDGE FETTING: Okay.

3 MR. CHIRNOMAS: Yeah, I mean, that's, that's what a centralized  
4data base is for, yes.

5 JUDGE FETTING: Right. Okay.

6 MR. CHIRNOMAS: So -- but we also have, you know, the part  
7information request means, the storage means and the order means and --

8 JUDGE FETTING: But all of that is -- there's no quarrel that all that  
9is in this reference. You haven't raised any of those as an issue.

10 MR. CHIRNOMAS: Right. Well, I mean --

11 JUDGE FETTING: I haven't seen it. Can you, can you point out  
12where you raised those as an issue?

13 MR. CHIRNOMAS: Right, well -- I have some place here; if you'd  
14give me a moment, please. This, this goes back to the response of  
15September 6th of '05. It's not in the Appeal Brief, and this is sort of based  
16on the Examiner's previous interpretation that the central computer  
17contained the data base files and I suppose what, what we were arguing was  
18--

19 JUDGE FETTING: Where, where are you pointing to? I'm sorry.

20 MR. CHIRNOMAS: This is in the response of September 6th, '05.

21 JUDGE FETTING: Is it -- can you point me to the brief on Appeal?

22 MR. CHIRNOMAS: No, it's not included.

23 JUDGE FETTING: Okay, so it's not before us then.

24 MR. CHIRNOMAS: Okay.

25 JUDGE FETTING: Okay, thank you. I have no further questions.

26 JUDGE LORIN: I just want to make sure I understand the issue.

1 You're saying that this line on Figure 1-B going from the video disk to the  
2 work station computer -- that's the line that you pointed to.

3 MR. CHIRNOMAS: Well, we've also discussed the line between the  
4 local data base and the --

5 JUDGE LORIN: Work station. You're saying according to the  
6 reference that those lines represent buses?

7 MR. CHIRNOMAS: Yes.

8 JUDGE LORIN: And that your claim calls for a communication  
9 network.

10 MR. CHIRNOMAS: Right.

11 JUDGE LORIN: Now, do you define communication network in  
12 your specification?

13 MR. CHIRNOMAS: Yes, we say on Page -- I don't know if you have  
14 it before you, but on --

15 JUDGE FETTING: It's at what page?

16 MR. CHIRNOMAS: It's on Page 7.

17 JUDGE FETTING: Page 7.

18 MR. CHIRNOMAS: Lines 2 and 3, it says that a communication  
19 network 3 is for example a www, World Wide Web such as the internet.

20 JUDGE FETTING: So that's an example, not a definition. Right?

21 MR. CHIRNOMAS: Well, it's -- yeah it's a definition, not --

22 JUDGE FETTING: It's a, it's a -- right, it's an example.

23 MR. CHIRNOMAS: It's a, it's an inclusive, yeah.

24 JUDGE FETTING: It's so -- yeah -- so you don't have a  
25 lexicographic definition. You haven't, you haven't, you haven't waived any  
26 subject matter --

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1 MR. CHIRNOMAS: Right, right, we haven't made an exclusive --

2 JUDGE FETTING: -- as by virtue of saying that.

3 JUDGE FETTING: Yeah, right.

4 JUDGE LORIN: Okay, I don't think there are any more questions.

5So thank you, Counsel.

6 MR. CHIRNOMAS: Okay.

7 JUDGE LORIN: We'll take your comments under advisement.

8 MR. CHIRNOMAS: Okay, thank you very much.

9 (Whereupon, the proceedings concluded.)